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12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

MAILED

FEB 24 2009

OFFICE OF PETITIONS

In re Application :
Aya Jacobovits et al. :
Application No. 09/771,312 :
Filed: January 26, 2001 :
Attorney Docket No. 511582000100 :
DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705 filed December 15, 2008. Applicant requests that the determination of patent term adjustment be increased by 692 days from 606 days to 1298 days. This request is based in part on the Office taking in excess of three years to issue the patent.

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is ordinarily required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). It is noted that at the time of this decision, the patent has not issued.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is GRANTED.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is six hundred nineteen (**619**) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On September 15, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 606 days. The instant application for patent term adjustment was timely filed¹ on or before payment of the issue fee.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 813 days for Office delay and the periods of reduction of 14, 87, 36, 70 and 9 days for applicant delay (in association with the responses filed March 21, 2008, August 7, 2007, November 3, 2006, October 13, 2005 and March 24, 2005).

Applicants dispute the entry of a period of reduction of 61 days for applicant's response to the Notice to File Missing Parts mailed January 10, 2002. Applicants argue that the response was filed May 28, 2002 and calculate Applicant delay at 48 days, but the Office incorrectly indicates the response was filed June 10, 2002 and incorrectly calculates 61 days of applicants' delay. Applicants assert that the correct number of days of delay is 48 in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b). Thirteen (13) days are at issue.

The reduction of 61 days has been found to be incorrect. A review of the application file reveals that, as stated by applicants, their response to the Notice to File Missing Parts of Application mailed January 10, 2002, is of record in the application with a date of receipt by the Office of May 28, 2002. Furthermore, the response, an executed declaration pursuant to 37 CFR 1.63 and fee for late filing, substitute specification and two month extension of time request constituted a complete reply to the Notice. Thus, the Office should not have entered the date that the instant application was complete as June 10, 2002 or assessed applicants a delay of sixty-one (61) days. The period of reduction of 61 days is being removed and a period of reduction of forty-eight (48) days is being entered.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is six hundred nineteen (619) days.

¹ PALM records indicate that the issue fee was paid on December 15, 2008.


Applicants also note that a Supplemental Information Disclosure Statement was filed on November 10, 2008 and that the Patent Term Adjustment should be reduced by an additional 120 days of applicants' delay, in accordance with 37 CFR 1.704(c)(10).

As acknowledged by applicants, this disclosure is premature. The revised patent term adjustment indicated on the patent will include any periods of reduction (or adjustment) accrued after the mailing of the notice of allowance on September 15, 2008.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

Day : Thursday
Date: 2/12/2009

PALM INTRANET

Time: 18:30:12

PTA Calculations for Application: 09/771312

Application Filing Date:	01/26/2001	PTO Delay (PTO):	883
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	277
Post-Issue Petitions:	0	Total PTA (days):	619
PTO Delay Adjustment:	13		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
146	02/09/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		48	
145	02/09/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	61		
110	09/15/2008	MAIL NOTICE OF ALLOWANCE	70		90
109	09/12/2008	ISSUE REVISION COMPLETED			
108	09/12/2008	DOCUMENT VERIFICATION			
107	09/12/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
106	09/12/2008	EXAMINER'S AMENDMENT COMMUNICATION			
105	09/12/2008	NOTICE OF ALLOWABILITY			
104	03/21/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
100	07/13/2008	DATE FORWARDED TO EXAMINER			
99	06/18/2008	APPEAL BRIEF FILED			
98	06/18/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
97	06/18/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
96	06/26/2008	FILING RECEIPT - CORRECTED			
95	03/21/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		14	90
94	03/21/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
93	03/18/2008	NOTICE -- DEFECTIVE APPEAL BRIEF			
92	03/14/2008	APPEAL BRIEF REVIEW COMPLETE			
91	03/14/2008	DATE FORWARDED TO EXAMINER			
90.1	03/07/2008	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
90	03/07/2008	APPEAL BRIEF FILED			

89	03/07/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
88	09/06/2007	MAIL ADVISORY ACTION (PTOL - 303)			
87	09/04/2007	ADVISORY ACTION (PTOL-303)			
86	08/09/2007	DATE FORWARDED TO EXAMINER			
85	08/07/2007	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
84	08/07/2007	NOTICE OF APPEAL FILED		87	80
83	08/07/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
82	11/03/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
81	11/03/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
80	02/12/2007	MAIL FINAL REJECTION (PTOL - 326)			
79	02/05/2007	FINAL REJECTION			
78	11/27/2006	DATE FORWARDED TO EXAMINER			
77	11/03/2006	RCE- AF PROCESSED			
76	11/27/2006	DATE FORWARDED TO EXAMINER			
75	11/03/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)		36	67
74	11/27/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
73	11/03/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
72	11/03/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
71	10/31/2006	MAIL ADVISORY ACTION (PTOL - 303)			
70	10/27/2006	ADVISORY ACTION (PTOL-303)			
69	10/10/2006	DATE FORWARDED TO EXAMINER			
68	09/28/2006	AMENDMENT AFTER FINAL REJECTION			
67	06/28/2006	MAIL FINAL REJECTION (PTOL - 326)			
66	06/26/2006	FINAL REJECTION			
65	04/08/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
64	02/10/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
63	04/14/2006	DATE FORWARDED TO EXAMINER			
62	04/07/2006	RESPONSE AFTER NON-FINAL ACTION			
61.7	02/10/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

61	02/10/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
60.7	04/08/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
60	04/08/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
59	12/18/2001	PRELIMINARY AMENDMENT			
58	01/13/2006	MAIL NON-FINAL REJECTION			
57	01/09/2006	NON-FINAL REJECTION			
56	10/25/2005	DATE FORWARDED TO EXAMINER			
55	10/13/2005	RESPONSE AFTER NON-FINAL ACTION		70	53
54	10/13/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
53	05/04/2005	MAIL NON-FINAL REJECTION			
52	05/02/2005	NON-FINAL REJECTION			
51	03/29/2005	DATE FORWARDED TO EXAMINER			
50	03/24/2005	RESPONSE TO ELECTION / RESTRICTION FILED		9	48
49	03/24/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
48	12/15/2004	MAIL RESTRICTION REQUIREMENT			
47	12/13/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
46	12/03/2004	MAIL NOTICE OF RESCINDED ABANDONMENT			
45	12/03/2004	NOTICE OF RESCINDED ABANDONMENT IN TCS			
44	08/17/2004	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
43	07/21/2004	PETITION ENTERED			
42	06/16/2004	MAIL EXPRESS ABANDONMENT (DURING EXAMINATION)	813		-1
41	06/14/2004	EXPRESS ABANDONMENT (DURING EXAMINATION)			
40	06/03/2004	LETTER OF EXPRESS ABANDONMENT FILED			
39	06/03/2004	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
38	05/11/2004	CASE DOCKETED TO EXAMINER IN GAU			
37	04/22/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
36.7	02/28/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	02/28/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

35	04/14/2004	CORRESPONDENCE ADDRESS CHANGE			
34	03/23/2004	APPLICATION RETURN FROM OIPE			
33	03/23/2004	APPLICATION IS NOW COMPLETE			
32	03/23/2004	PRE-EXAM OFFICE ACTION WITHDRAWN			
31	03/23/2004	APPLICATION RETURN TO OIPE			
30	03/19/2004	APPLICATION RETURN FROM OIPE			
29	03/19/2004	APPLICATION IS NOW COMPLETE			
28	08/15/2003	CORRESPONDENCE ADDRESS CHANGE			
26	12/18/2002	ADDITIONAL APPLICATION FILING FEES			
25	12/18/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
24	10/10/2002	SEQUENCE ERRORS			
23	10/10/2002	CORRESPONDENCE ADDRESS CHANGE			
22	10/10/2002	SEQUENCE ERRORS			
21	06/10/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN		61	10
20	06/25/2002	PRE-EXAM OFFICE ACTION WITHDRAWN			
19	10/10/2002	APPLICATION RETURN TO OIPE			
18	10/01/2002	APPLICATION MADE UNAVAILABLE FOR EXAMINATION			
17	09/12/2002	CASE DOCKETED TO EXAMINER IN GAU			
16	07/24/2002	APPLICATION DISPATCHED FROM OIPE			
15	06/25/2002	APPLICATION IS NOW COMPLETE			
13	05/28/2002	ADDITIONAL APPLICATION FILING FEES			
12	05/28/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
11	05/28/2002	APPLICANT HAS SUBMITTED A NEW SPECIFICATION TO CORRECT CORRECTED PAPERS PROBLEMS			
10	01/10/2002	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
6	12/26/2001	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
5	05/16/2001	XXXXX			
4	05/16/2001	MISCELLANEOUS INCOMING LETTER			
3	04/18/2001	MISCELLANEOUS OFFICE ACTION MAILED			
2	02/17/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			

Search Another: Application#

Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to [OASIS](#) | [Home page](#)